

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YUJI SUZUKI and KAZUMI MUNEKATA

Appeal No. 96-0643
Application 08/103,677¹

HEARD: January 14, 1999

Before URYNOWICZ, KRASS, and CARMICHAEL, Administrative Patent Judges.

CARMICHAEL, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of Claims 1-2, 4-10, and 12-13. It appears from the Examiner's Answer that the rejections of the other remaining claims, Claims 3 and 11, have been withdrawn.

¹ Application for patent filed August 10, 1993.

Claim 1 reads as follows:

1. A disk drive apparatus for recording and reproducing an information signal on and from a recording medium pivotally received within a disk cartridge, the disk drive apparatus comprising:

a head assembly having a head arm for holding an upper head and a head carriage for carrying a lower head, said head arm and said head carriage being connected together on a lateral side of the disk cartridge and extending in a direction perpendicular to an inserted direction of said disk cartridge, respectively; and

a moving means for moving said head assembly in said inserted direction of said disk cartridge, said moving means being disposed below and substantially within a length and width of the disk cartridge, whereby a length and width of the disk drive apparatus is similar but slightly larger than the length and width of the disk cartridge.

The examiner's Answer cites the following prior art:

Hasegawa	4,783,708	Nov. 8, 1988
Liu	4,974,107	Nov. 27, 1990
Suzuki	61-74181	Apr. 16, 1986
(Japanese Patent)		

OPINION

This appeal involves the following six rejections.

First, Claims 4-6, 9-10, and 12 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Second, Claims 1-2 stand rejected under 35 U.S.C. § 103 as unpatentable over admitted prior art Figure 8B in view of admitted prior art Figure 7. Third, Claims 7-10 stand rejected under 35 U.S.C. § 103 as unpatentable over admitted prior art Figure 8B in view of admitted prior art Figure 7

as applied to Claims 1-2, and further in view of Liu. Fourth, Claim 13 stands rejected under 35 U.S.C. § 103 as unpatentable over admitted prior art Figure 8B in view of admitted prior art Figure 7 as applied to Claims 1-2, and further in view of Suzuki. Fifth, Claims 4-5 and 12 stand rejected under 35 U.S.C. § 103 as unpatentable over admitted prior art Figure 8B in view of Liu. Sixth, Claim 6 stands rejected under 35 U.S.C. § 103 as unpatentable over admitted prior art Figure 8B in view of Liu as applied to Claims 4-5, further in view of Hasegawa.

1. Indefiniteness of Claims 4-6, 9-10, and 12

Claims 4-6, 9-10, and 12 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite.

According to the examiner, Claim 4 is indefinite due to the phrase “generally coplanar portions.” The examiner states that the base portion illustrated in the Figures is not generally coplanar with the head holding portion.

Appellants consider the recited “base portion” to include head arm support portion 77 and base lug 81. As illustrated in Figure 3, that base portion is generally coplanar with head holding portion 83. In any event, Claim 4 does not require the entire “base portion” be generally coplanar with the head holding portion. Claim 4 only requires a “portion” of the base portion be generally coplanar with the head holding portion. Portion 81 is a “portion” of the base portion generally coplanar with the head holding portion. We can discern no indefiniteness in Claim 4.

Since the examiner offers no other objection to the claims, the indefiniteness rejection of Claims 4-6, 9-10, and 12 is not sustained.

2. Obviousness of Claims 1-2

Claims 1-2 stand rejected under 35 U.S.C. § 103 as unpatentable over admitted prior art Figure 8B in view of admitted prior art Figure 7.

The examiner concedes that the admitted prior art does not disclose a moving means “substantially within” a length and width of the disk cartridge as recited in Claims 1 and 2. Examiner’s Answer at 5. According to the examiner, such a modification “would have been a matter of routine engineering skill.”

The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992). In the present case, the examiner’s invocation of “routine engineering skill” does not address the requirement that the prior art suggest the desirability of the modification under *In re Fritch*. Upon our own review of the admitted prior art, we are unable to identify such a suggestion. Therefore, the rejection of Claims 1 and 2 over admitted prior art will not be sustained.

3. Obviousness of Claims 7-10

Claims 7-10 stand rejected under 35 U.S.C. § 103 as unpatentable over admitted prior art Figure 8B in view of admitted prior art Figure 7 as applied to Claims 1-2, and further in view of Liu. The rejection of Claims 7-10 relies on the rationale, rejected above, applied to Claims 1-2. Therefore, we will not sustain this rejection.

4. Obviousness of Claim 13

Claim 13 stands rejected under 35 U.S.C. § 103 as unpatentable over admitted prior art Figure 8B in view of admitted prior art Figure 7 as applied to Claims 1-2, and further in view of Suzuki. The examiner's rejection of Claim 13 relies on the rationale, rejected above, applied to Claims 1-2. Therefore, we will not sustain this rejection.

5. Obviousness of Claims 4-5 and 12

Claims 4-5 and 12 stand rejected under 35 U.S.C. § 103 as unpatentable over admitted prior art Figure 8B in view of Liu. The examiner concedes that the admitted prior art does not show a bearing portion interposed between coplanar portions of the head holding portion and the base. For that, the examiner relies on Liu.

At oral argument, appellants persuasively argued that there is no motivation or suggestion to combine Liu and the admitted prior art in the particular arrangement claimed. We agree. Even if Liu disclosed a bearing portion interposed between coplanar portions of the base and the head

holder, and even if one skilled in the art was motivated to incorporate Liu's teachings regarding the guideshaft into the admitted prior art, it appears that such a combination would result in the claimed invention only with the improper use of appellants' specification as a template.

6. Obviousness of Claim 6

Claim 6 stands rejected under 35 U.S.C. § 103 as unpatentable over admitted prior art Figure 8B in view of Liu as applied to Claims 4-5, further in view of Hasegawa. The examiner's rejection of Claim 6 relies on the rationale, rejected above, applied to Claims 4-5. Therefore, we will not sustain this rejection.

7. New Ground of Rejection

Claims 1-2, 7-10, and 13 are hereby rejected under 35 U.S.C. § 103 as unpatentable over Suzuki (see translation included herewith). Suzuki appears to disclose the claimed subject matter except for an upper head arm. It would have been obvious to one of ordinary skill in the art to add an upper head arm to Suzuki (which already has a lower head arm) because discs are now commonly

two-sided.

Suzuki's moving means are motor 4 and steel band 5. These are equivalent to appellants' disclosed moving means (motor 74 and link member 90).

Appellants argue that Suzuki does not teach a moving means "substantially within a length" of the disk cartridge. We disagree.

Claims undergoing examination are given their broadest reasonable interpretation consistent with the specification, and limitations appearing in the specification are not to be read into the claims. *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (in banc). In the present case, "substantially within a length" includes Suzuki's moving means which are shown in the drawings as about forty percent within a length of the disk cartridge. Thus far, appellants have pointed to nothing in the specification with which this interpretation is inconsistent. Thus, we find that Suzuki's moving means is "substantially within a length" of the disk cartridge.

Moreover, even if "substantially" required more than half, Suzuki suggests overlapping to a greater degree than shown in Suzuki's drawings, in order to reduce the total length of the entire device. Suzuki (translation) at 5, lines 2-7. Thus, Suzuki suggests making a moving means more than fifty percent within the length of the disk cartridge.

CONCLUSION

The examiner's rejections are not sustained. We enter a new ground of rejection against Claims 1-2, 7-10, and 13.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED IN PART--37 CFR 196(b)

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STANLEY M. URYNOWICZ Jr.)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ERROL A. KRASS)	
Administrative Patent Judge)	APPEALS AND

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JAMES T. CARMICHAEL
Administrative Patent Judge

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